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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,667	01/18/2002	Paul M. Magee	82306JLT	1164

7590

08/29/2003

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,667

Applicant(s)

MAGEE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

This is in response to Papers filed on 21 August 2003.

I. Applicants' prior art submission filed on 15 April 2003 has been considered to the extent of the English language as provided on the record only. None of them is now applied since this Office action may not be made final. One or more of them will be next in line to be applied in the event that the applied references the record with respect to Kramp et al is overcome.

II. Claims 1-19 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramp et al (4,254,215).

Kramp et al disclose, teach and suggest a black-and-white developer comprising a sufficient amount of a black-and-white developing agent and a sufficient anti-sludging agent being read within the general formula II (compound No. 9 on column 13) and its analogue (compounds Nos. 6, 7, 8 on column 9; 1, 2 on column 11; 3 on column 12 with respect to a reverse amido group as compared to those being read within the general formula II in accordance with the authority stated in *In re Ward*, 141 USPQ227, *In re Carabateas*, 148 USPQ 282 and *In re Wetterau*, 148 USPQ 499). Please see the whole disclosure of the applied reference, especially at the general formula I from col.2:54 to 18:48 and black-and-white developer in the Examples. Since Kramp et al disclose, teach and suggest the known use of the essential and main anti-sludging agent and its analogue in a black-and-white developer in the claims, they are found to be rendered *prima facie* obvious by Kramp et al to one having ordinary skill in the art at the time the invention was made. The showings in the Examples of the instant application have been

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considered but have and are given a little to no value as compared the broadly claimed embodiments.

III. Applicant's arguments filed 21 August 2003 have been fully considered but they are not persuasive.

Applicants recognize Kramp et al disclose the claimed compound 9 but (1) fail to recognize any one of the analogues (compounds Nos. 6, 7, 8 on column 9; 1, 2 on column 11; 3 on column 12 with respect to a reverse amido group as compared to those being read within the general formula II in accordance with the authority stated in *In re Ward*, 141 USPQ227, *In re Carabateas*, 148 USPQ 282 and *In re Wetterau*, 148 USPQ 499) as clearly pointed out on the record, (2) other compounds are disclosed, taught and suggested and (2) compound 9 is not found in any Kramp et al Examples.

It is submitted that a pertinent teaching or suggestion in a reference is not limited to a working example. Should applicants limit the claims to the working examples only in order for the arguments to have some merits?

The language "comprising" in the claims is open to an inclusion of an additional ingredient. There is also no evidence on the record as the time the application is filed that any additional ingredient would cause a deleterious composition as broadly claimed. Accordingly, the arguments have no merits and value by the evidence on the record.

In any showing, it would like to see a tested result at about 0.000 007 mol/l (page 6, line 26) of a compound of the formulas as broadly claimed. Otherwise, the language "an amount sufficient to inhibit sludge deposition" has and is given no value as a supposition only since there

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is no evidence that applicants could be able to provide for the record but it is given the value at about amounts as tested only. Applicants are urged to show or provide an evidence to the contrary.

IV. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers of the examiner is 703-746-7172. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is

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not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
27 August 2003

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Hoa Van Le", written in a cursive style.